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09/730,232

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EXAMINER

MOONEYHAM, JANICE A

ART UNIT

PAPER NUMBER

3629

DATE MAILED: 12/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/730,232

Applicant(s)

POLTORAK, ALEXANDER I.

Examiner

Jan Mooneyham

Art Unit

3629

WU

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 05 December 2000 and 19 August 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-53,66-72,86 and 87 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-53,66-72,86 and 87 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

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1. This is in response to the applicant's communication filed on December 5, 2000 and August 19, 2004. Claims 1-53, 66-72 and 86-87 are currently pending in this application. Claims 54-65 and 73-85 have been cancelled. Claims 17, 25, and 39 have been amended.

***Information Disclosure Statement***

2. The information disclosure statement (IDS) submitted on December 26, 2002 is being considered by the examiner.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 21, 52 and 53 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As for Claim 21, 52 and 53 the applicant states in the preamble that the invention is a method and system for searching intellectual property listings. However, there is no searching step in the claim language.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

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4. Claims 1-16, 19-20, and 39-44 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

In the present case, claims 1-16, 19-20, and 39-44 only recite an abstract idea. The recited steps of merely maintaining a user interface, establishing a connection, receiving criteria, searching and presenting results does not apply, involve, use, or advance the technological arts since all of the recited steps can be performed in the mind of the user or by use of a pencil and paper. These steps only constitute an idea of how to search intellectual property listings. There is not positive recitation of technology in the body of the claims.

Mere intended or nominal use of a component, albeit within the technological arts, does not confer statutory subject matter to an otherwise abstract idea if the component does not apply, involve, use, or advance the underlying process.

In the present case, the mention of maintaining a user interface site is analogous to non-functional descriptive data.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1, 4, 8-10, and 20 are rejected under 35 U.S.C. 102(e) as being anticipated by Lundberg (US 2002/0091541) (hereinafter referred to as Lundberg).

Referring to Claim 1:

Lundberg discloses a method and system of searching intellectual property listings, comprising:

- a) maintaining a user-interface site accessible by a plurality of users (Fig. 1);
- b) establishing a connection to a plurality of third-party sources of intellectual property listings (Fig. 1);
- c) receiving from at least one of said plurality of users search criteria for searching said plurality of third-party sources of intellectual property listings (Fig. 2);
- d) searching said plurality of third-party sources of intellectual property listings according to said search criteria (Fig. 2);
- e) presenting a resulting set of intellectual property listings to said at least one of said plurality of users (Fig. 2); and

t) receiving from said at least one of said plurality of users an identification of those of said resulting set of intellectual property listings that are of interest to said at least one of said plurality of users (Fig. 2, pages 1-2 [0009]).

Referring to Claim 4:

Lundburg discloses a method further comprising the step of, establishing contact between said at least one of said plurality of users and those of said plurality of third-party sources including those of said resulting set of intellectual property listings which are of interest to said at least one of said plurality of users (Figs. 1-2).

Referring to Claim 8:

Lundburg discloses a method wherein the step of searching said plurality of third-party sources includes the steps of:

- a) designating a buffer memory for temporary storage of intellectual property listings matching said search criteria (a memory is inherent in the system (Figs. 1-2);
- b) reformatting said search criteria according to requirements of each of said plurality of third-party sources of intellectual property listings (Figs. 1-2);
- c) searching through the intellectual property listings of said each of said plurality of third-party sources for matches with said respective reformatted search criteria (Figs. 1-2); and
- d) collecting such intellectual property listings that match said reformatted criteria and storing said listings in said buffer memory (Figs. 1-2).

Referring to Claim 9:

Lundburg discloses a method further comprising the step of: reformatting said intellectual property listings stored in said buffer memory in a

Art Unit: 3629

predetermined format prior to presentation thereof to said at least one of said plurality of users

(Figs. 1-2).

Referring to Claim 10:

Lundburg discloses a method further comprising the step of: )  
reordering said intellectual property listings stored in said buffer memory according to  
predefined criteria prior to presentation thereof to said at least one of said plurality of users (Figs.  
1-2).

Referring to Claims 20 and 44:

Lundburg discloses a method wherein said user-interface site is a website (Figs. 1-2).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all  
obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 21-39, and 45-53 are rejected under 35 U.S.C. 103(a) as being unpatentable over  
Tran (US 2002/0095368) (hereinafter referred to as Tran).

Referring to Claims 21-22 and 45-53:

Tran discloses a method and system for searching intellectual property listings online,  
comprising the steps of:

- a) maintaining a user-interface site accessible by a plurality of users (Fig. 1);
- b) maintaining access to a predetermined set of third-party sources of  
intellectual property listings searchable online (page 1 [0006] thru page 2 [0012]);

c) eliciting from each user search criteria for searching each of said third-party sources of intellectual property listings (page 1 [0006] thru page 2 [0012]);

d) designating first and second memory storage areas for storage of intellectual property listings (page 1 [0006] thru page 2 [0012]),

Tran does not disclose taking a snapshot of each of said third-party sources of intellectual property listings, storing said snapshots in said first memory storage area, reformatting each of said snapshots in a predetermined format, and storing said reformatted snapshots in said second memory storage area.

However, Tran discloses storing information that can be elicited from search criteria. The fact that the data is stored by making a snapshot is a design choice and would have been obvious to one of ordinary skill in the art at the time the invention was made.

Referring to Claim 23:

Tran discloses further comprising the steps of;

p) presenting a resulting set of intellectual property listings to said user (page 1 [0006] thru page 2 [[0012]); and

q) eliciting from said user an identification of those intellectual property listings which are of interest (page 1 [0006] thru page 2 [0012]).

Referring to Claim 24:

Tran discloses a method further comprising the step of:

r) securing permission from each of said third-party sources of intellectual property listing allowing search of said third-party sources and presenting listings therefrom to said user (page 3 [0022] page 4 [0004]).



Referring to Claim 25:

Tran discloses a method further comprising the step of:

s) securing from each of said third-party sources of intellectual property listings a fee-sharing agreement in respect of any fees paid as a result of transactions arising out of contacts initially made through said user-interface site (pages 3-4 [0022-0023]).

Referring to Claims 26-27:

Tran discloses a method further comprising the step of:

r) establishing contact between said user and the third party maintaining said intellectual property listings which are of interest (page 1 [0006] thru page 2 [0012]).

Referring to Claim 28:

Tran discloses a method further comprising the step of:

r) providing said user with  
a transaction manager to facilitate a contemplated intellectual  
property transaction (page 1 [0006] thru page 2 [0012]).

Referring to Claim 29:

Tran discloses a method further comprising the step of:

s) said transaction manager contacting said  
third party maintaining the listings of the  
intellectual property being of interest to said user to facilitate said transaction (page 1 [0006] thru  
page 2 [0012]).

Referring to Claims 30-32:

Tran disclose a method further comprising the steps of:

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- r) designating a memory for temporary storage of intellectual property listings matching said search criteria elicited from said user (page 1 [0006] thru page 2 [0012]);
- s) searching through said reformatted snapshots in said second memory storage area for matches with said search criteria (page 1 [0006] thru page 2 [0012]), and
- t) collecting such intellectual property listings that match said criteria and storing said listings in said buffer memory (Figs 1, page 1 [0006] thru page 2 [0012]).

Referring to Claims 33-39:

Tran discloses a method further comprising the step of making available to said user analytical tools for valuation and analysis of the intellectual property, wherein said analytical tools are not available from the third party maintaining said intellectual property listings which are of interest, further comprising making available to said user escrow services related to a contemplated intellectual property transaction, wherein said services are not available from the third party maintaining said listings of said intellectual property which are of interest, comprising the step of making available to said user title insurance covering the intellectual property which is the subject of a contemplated intellectual property transaction, wherein said title insurance is not available from the third party maintaining intellectual property listings which are of interest, further comprising the step of making available to said user patent validity insurance covering the intellectual property which is the subject of a contemplated intellectual property transaction, wherein said patent validity insurance is not available from the third party maintaining said intellectual property listings which are of interest, further comprising the step of making available to said user consulting services related to a

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contemplated intellectual property transaction, further comprising the step of making available to said user legal services related to a contemplated intellectual property transaction (pages 2-3 [0016], [0019], pages 3-4 [0022]).

7. Claims 40-43, 66-70, and 86-87 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lundburg as applied to claim 39 and further in view of Tran..

Referring to Claims 40-43, 86-87:

Tran discloses wherein said goods comprise businesses available for sale, merger or acquisition, wherein said goods comprise venture capital available for investment, further comprising providing a transaction manager to facilitate a contemplated transaction between said user and the provider of said goods or services, wherein said third-party listings are comprised by Internet auction sites (page 2 [0016] thru page 4 [0022]).

Referring to Claims 66-70:

Tran discloses method and system for searching intellectual property listings online, comprising:

a) making available to a user a software application for installment on said user's computing device, said application comprising instructions to (page 4 [0023]):

- i. execute a query as specified by said user (page 4 [0023];
- ii. search predetermined Internet sites and exchanges (page 4[0023]);
- iii. display search results to said user via said terminal, said search results comprising one or more intellectual property listings; and

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iv. enabling said user to indicate a listing of interest (page 1 [0006] thru page 2 [0012]); and  
b) assigning a transaction manager to contact said user and the source of said listing to facilitate a desired transaction related to said listing of interest (page 2 [0016]).

8. Claims 2-3, 5-7, 11-19 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lundburg and Tran as applied to claims 1 and 21 above, and further in view of Magid (US 2001/0032144) (hereinafter referred to as Magid).

Magid discloses further comprising the step of:  
securing permission from each of said plurality of third-party sources of intellectual property listings for allowing a search of each said plurality of third-party sources (page 1 [0014]).

Magid discloses comprising the step of:  
securing from each of said plurality of third-party sources of intellectual property listings a fee-sharing agreement (page 1 [0013] thru page 2 [0021]).

Magid discloses a method further comprising the step of:  
providing said at least one of said plurality of users with a transaction manager to facilitate a contemplated intellectual property transaction, further comprising the step of:  
having said transaction manager contact those of said plurality of third-party sources including those of said resulting set of intellectual property listings which are of interest to said at least one of said plurality of users to facilitate said contemplated intellectual property transaction (page 2 1-2 [0013]0021)).

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Magid discloses further comprising the step of:  
making available to said at least one of said plurality of users analytical tools for valuation and analysis of the intellectual property, further comprising the step of:  
making available to said user escrow services related to a contemplated intellectual property transaction, further comprising the step of:  
making available to said user title insurance covering the intellectual property which is the subject of a contemplated intellectual property transaction, further comprising the step:  
making available to said user patent validity insurance covering the intellectual property which is the subject of a contemplated intellectual property transaction, further comprising the step of making available to said user consulting services related to a contemplated intellectual property transaction (page 3 [0034]),

Referring to Claims 5 and 27:

Neither Lundburg nor Magid, nor Tran disclose wherein the step of establishing contact includes the steps of:

- a) hyperlinking said user with said those of said plurality of third-party sources; and
- b) transmitting to said those of said plurality of third-party sources a unique identifier for identifying said user-interface site as the source of a contemplated intellectual property transaction.

However, this would have been obvious to one of ordinary skill in the art since this practice is well know in the computer industry and would allow quick access to resources.

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***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

A Global Technology Manager's Agenda discloses technology managers to manage IP.

Dwyer discloses a system for streamlining the process of creating, and preserving IP..

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jan Mooneyham whose telephone number is (703) 305-8554. The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (703) 308-2702. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

jm

  
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